

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 77

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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STEPHANIE J. OATES  
**Junior Party**<sup>1</sup>

v.

FRANCO RIVETTI, FIORENZO RENZI and UGO ROMANO  
**Senior Party**<sup>2</sup>

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Interference No. 102,622

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**HEARD: OCTOBER 25, 1996**

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<sup>1</sup> Application Serial Number 07/194,056, filed on May 13, 1988, now U.S. Patent Number 4,829,136, issued May 9, 1989. On this record, the involved patent is assigned to PPG Industries, Inc., a corporation of Pennsylvania.

<sup>2</sup> Application Serial Number 07/315,728, filed on February 24, 1989. Accorded benefit of Italian Application Serial Number 19645A/88, filed on March 4, 1988. On this record, the involved application is assigned to Enichem Synthesis, S.P.A., Palermo, Italy.

**FINAL DECISION**

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Before CALVERT<sup>3</sup>, CAROFF, and METZ, Administrative Patent Judges.

METZ, Administrative Patent Judge.

The subject matter contested in this interference is directed to a composition which is polymerizable and comprises a bisphenol bis(allylic carbonate). The compositions, when polymerized and cast, form useful lightweight optical materials suitable for lenses for eyeglasses.

The specific interfering subject matter contested by the parties is defined by the sole count in this interference, Count 1, which is set forth as follows:

**COUNT 1**

A polymerizable, homogeneous composition comprising bisphenol bis(allylic carbonate)-functional material comprising

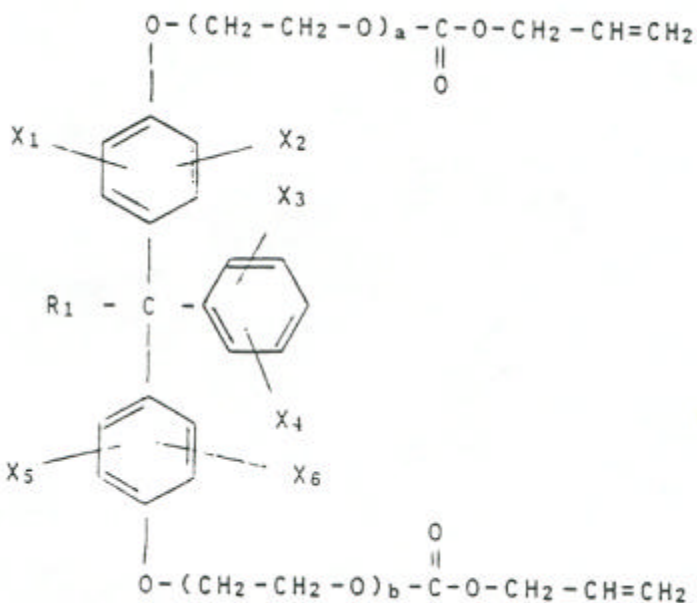
(a) 4,4-(1-phenylethylidene)bis[phenol]bis(allyl carbonate) monomer,

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<sup>3</sup> Judge Sofocleous, who served on the merits panel which heard oral argument, retired from government service before this decision was rendered.

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Liquid compositions, polymerizable by a free-radical route to yield optical articles possessing a high refractive index, comprising:

(a) from 20 to 80 percent by weight of an allyl-carbonate derivative represented by the formula

wherein:

R<sub>1</sub> is selected from the group consisting of a hydrogen atom, a linear (C1-C6)-alkyl radical, a branched (C1-6)-alkyl radical, a phenyl radical and a benzyl radical;

X<sub>1</sub>, X<sub>2</sub>, X<sub>3</sub>, X<sub>4</sub>, X<sub>5</sub>, and X<sub>6</sub> are independent from each other, and are selected from the group consisting of a hydrogen atom, a chlorine atom and a bromine atom; and

a and b are independent of each other, and are integers of from 0 to 3;

(b) from 80 to 20 percent by weight of a copolymerizable monomer having at least one ethylenic unsaturation in its molecule.

The claims of the parties which correspond to Count 1 are:

Oates: Claims 1 through 29

Rivetti et al.: Claims 10 through 29

Both parties filed briefs and Oates filed a reply brief. Only the junior party's legal representative appeared for oral argument at final hearing. No issue of interference-in-fact was raised by the parties in this proceeding.

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Although the official records in this proceeding show that Rivetti et al.'s involved application is owned by Enichem Synthesis, in their brief, Rivetti et al. represent that ownership has been transferred to another entity. That is, Rivetti et al. represent that their involved application is now owned by Great Lakes Chemical Company (see also Paper Number 57). Nevertheless, Rivetti et al. have not filed the requisite notice required by 37 C.F.R. § 1.602(c). Accordingly, it is ORDERED that within **10 (TEN) days** of the date of this decision, Rivetti et al. shall file a paper in compliance with the rule.

The issues presented for our consideration in this proceeding are priority of invention and the patentability of the junior party's claims corresponding to the count.

Oates presented a record including deposition testimony and associated documentary exhibits in support of her case for priority<sup>4</sup>. Rivetti et al. have elected to rely on their Italian priority benefit date of March 4, 1988, and are limited to a case-in-rebuttal only.

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<sup>4</sup> References to the Oates record will be designated as OR, followed by the record page number, and references to the Oates exhibits will be designated OX, followed by the exhibit number.

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Oates, as the junior party whose application was copending with Rivetti et al.'s U.S. application and which application matured to Oates' involved U.S. patent, bears the burden of proving her case for priority by a preponderance of the evidence. Morgan v. Hirsch, 728 F.2d 1449, 221 USPQ 193 (Fed. Cir. 1984); Peeler v. Miller, 535 F.2d 647, 190 USPQ 117 (CCPA 1976).

In order to be awarded priority in this interference, Oates must prove an actual reduction to practice prior to March 4, 1988, Rivetti et al.'s effective filing date. Alternatively, Oates could prevail by proving a conception of the subject matter of the count before Rivetti et al.'s effective filing date of March 4, 1988, coupled with reasonable diligence just prior to March 4, 1988, up to a reduction to practice (constructive or actual) by Oates. Jepson v. Egly, 231 F.2d 947, 109 USPQ 354 (CCPA 1956); Hull v. Davenport, 24 CCPA (Patents) 1116, 90 F.2d 103, 33 USPQ 506; Wilson v. Sherts, 81 F.2d 755, 28 USPQ 379 (CCPA 1936).

#### **THE PATENTABILITY OF OATES' CLAIMS**

During the preliminary motions phase of this proceeding, Rivetti et al. moved, *inter alia*, for judgment against Oates in two, separate motions filed under 37 C.F.R.

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§ 1.633(a) (Paper Numbers 15 and 16) on the grounds that Oates' claims corresponding to the count were (1) unpatentable under 35 U.S.C. § 103 from the disclosure of Bralley et al. (U.S. Patent Number 2,455,653) and (2) were unpatentable from the disclosure of Misura et al. (U.S. Patent Number 4,959,429). The Administrative Patent Judge (APJ), in the performance of his interlocutory duties, denied both motions for reasons expressed in the decision on motions (Paper Number 47). In Paper Number 51, Rivetti et al. requested reconsideration of that portion of the APJ's decision on motions denying the motions for judgment.

In Paper Number 53, a three judge merits panel reconsidered the APJ's interlocutory decision but declined to make any changes in the decision below. Thus, the request for reconsideration was denied.

We have carefully reconsidered anew Rivetti et al.'s motion for judgment based on the record evidence but find that Rivetti et al. have failed to meet their burden of persuasion on this issue. Specifically, notwithstanding Rivetti et al.'s "adjacent homolog" theory, we find that nothing in the Bralley et al. patent would have directed a person of ordinary skill in the art to prepare the compounds claimed by Oates. While

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we agree with Rivetti et al.'s broad characterization of Bralley et al.'s disclosure as "generic" to or encompassing the species claimed by Oates, nothing in Bralley et al. suggests that polymers as claimed by Oates would have been expected to possess high refractive indices which make them especially suitable for optical quality plastic. We also find, assuming, *arguendo*, a person of ordinary skill in the art would have been motivated to make Oates' claimed compounds because they were the next adjacent homologues to certain compounds disclosed in Bralley et al., that there is no suggestion in Bralley et al. of what reactants could be used to prepare such hypothetical compounds. A reference may not render a particular compound obvious in the sense of 35 U.S.C. § 103 absent a disclosure which would have enabled a person of ordinary skill in the art to prepare said particular compound.

We have also carefully considered anew Rivetti et al.'s motion for judgment based on the patent to Misura et al. but find that, on its face, the patent is not prior art with respect to Oates because the application from which it issued was filed on May 19, 1988, after Oates' effective filing date and because the Misura et al. patent issued on September 25, 1990, after Oates' involved patent issued. Rivetti et al.



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have failed to prove that the Misura et al. patent is entitled to an earlier filing date than the actual filing date of the application which matured to the patent. We also observe that if the Misura et al. patent is entitled to either the February 24, 1986, filing date or the November 22, 1985, filing date as alleged by Rivetti et al., the Misura et al. patent would also render Rivetti et al.'s claims unpatentable for the reasons urged by Rivetti et al. with respect to Oates' claims. We simply observe that Rivetti et al. have not explained why, if the motion were granted based on Misura et al.'s disclosure, the same prior art would not render their claims corresponding to Count 1 unpatentable.<sup>5</sup> Additionally, Rivetti et al.'s motion lacks any evidence establishing that the Misura et al. disclosure would have motivated a person of ordinary skill in the art to make the compounds claimed by Oates in her involved patent.

#### **OATES' CASE FOR PRIORITY**

In her opposition to Rivetti et al.'s motion for additional discovery (Paper Number 49), Oates represented that:

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<sup>5</sup> See 37 C.F.R § 1.637(a), third sentence (1995).

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the party Oates will refrain from relying on any actual reduction to practice in presenting its case for priority in this interference as presently declared and constituted

In Paper Number 52, the APJ, in his order denying additional discovery, specifically held in light of Oates' above-noted representation that:

Oates may not prove priority in this interference by showing an actual reduction to practice of the subject matter of the count before Rivetti et al.'s effective filing date.

Accordingly, Oates is limited to proving priority by proving by a preponderance of the evidence that she conceived her invention before the filing date of Rivetti et al.'s Italian benefit application coupled with reasonable diligence from a date just prior to Rivetti et al.'s filing date up to a reduction to practice by Oates.

In her preliminary statement (Paper Number 8), Oates alleges: the invention defined by Count 1 was first conceived by her July 30, 1985; she conceived of the invention of Count 1 in this interference in the United States (see paragraph (4) of Paper Number 9); the date active exercise of reasonable diligence toward reducing the invention to practice began was

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on July 30, 1985; and, that such active exercise began in the United States (see paragraph (6) of Paper Number 9).

The facts concerning Oates' conception are not disputed by the parties. In 1987, at a time when Ms. Oates worked for PPG in their laboratory in Barberton, Ohio, Ms. Oates filed with the PPG patent department a memorandum of invention (MOI) on December 2, 1987, directed to the preparation of high refractive index optical plastic from bisphenol AP (OR p.37-42; OX-3). The MOI was witnessed by Paul A. Adair on December 2, 1987 (OR p.41) and receipt of the MOI was acknowledged by Mr. Stein in a letter to Ms. Oates dated December 15, 1987 (OR p.43-44; OX-4). Stein has testified that he remembers having his secretary prepare the December 15, 1987, letter to Ms. Oates acknowledging receipt of the MOI by the patent department from the information contained in the MOI using a PPG form (OX-12) specifically designated for that purpose (OR p.161-170).

The MOI states that the invention was first described in writing in "Notebook 6748 7-31-85". Notebook 6748 is Ms. Oates' notebook (OX-1) and it included an account of her work from July 18, 1985, through June 2, 1986. On pages 8 and 9 of notebook 6748 there is described an

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experiment for "Preparation of Bisallylcarbonate of Bisphenol AP" (OX-1, p.'s 8 and 9). The MOI makes reference to preparation of the compound "4,4'("-methyl benzylidene)bisphenol" which is another name for the compound described in Count 1 as --- 4,4'-(1-phenylethylidene) bis[phenol]bis(allyl carbonate) monomer ---. It is also apparent from the notebook itself and from the MOI that Ms. Oates envisioned a practical utility, optical quality plastic with a high refractive index, for the bisallylcarbonate of bisphenol AP. Thus, Oates has established a conception of the subject matter of Count 1 by not later than December 15, 1987, which has been adequately corroborated by Mr. Stein's acknowledged receipt of the MOI in the patent department at PPG, which date is prior to Rivetti et al.'s March 4, 1988, filing date for their Italian priority application.

Accordingly, in order to be declared the first inventor of the subject matter of Count 1, Oates must establish by a preponderance of the evidence that she was "reasonably diligent" from a time just prior to March 4, 1988, up until a reduction to practice by Oates. Thus, Oates had to show that she was reasonably diligent during the time period from March 3, 1988, a date just prior to Rivetti et al.'s

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benefit date of March 4, 1988, to May 13, 1988, Oates' filing date for her involved application, a period of 71 days. For reasons which follow, we find Oates has failed to meet her burden of persuasion.

Oates represents that the following chain of events constitutes reasonable diligence: on March 2, 1988, Mr. Morris conducted a computer search for patents relevant to the subject matter of Oates' MOI (OX-14); Oates sent Morris additional information in response to a request by him for more details on the preparation of the allylic carbonate on March 10, 1988 (OX-5); Mr. Morris' secretary had a note, handwritten by her on March 25, 1988, indicating that Ms. Oates phoned with information for Mr. Morris while Mr. Morris was out of the office (OX-16); Mr. Morris had handwritten notes of a conversation he had with Oates bearing a date of April 4, 1988 (OX-15); on April 28, 1988, Morris sent Oates a first draft of the application for her review (OX-6); on May 4, 1988, Morris sent the final draft to Oates along with a letter of transmittal (OX-7); Oates signed the declaration/power of attorney; assignment and duty of disclosure document sent to her by Morris on May 9, 1988 (OX-9, OX-10); the duty of disclosure document was received by the

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patent department at PPG on May 12, 1988; Oates' application was filed in the United States' Patent and Trademark Office on May 13, 1988.

While acknowledging that there exist time periods within the seventy-one day critical time period for which no activity has been shown, Oates urges that only reasonable diligence needs to be proved in order to satisfy her burden of persuasion. Oates argues on the basis of work done by her or on her behalf by others that her evidence adequately establishes she was reasonably diligent in the critical time period. Contrariwise, Rivetti et al. urge that notwithstanding the fact that the courts have acknowledged a "liberal" standard for finding reasonable attorney diligence, the controlling decisions on this issue require more evidence of specific activity for every day in the critical time period than that presented by Oates. Rivetti et al. argue that Oates' proofs are inadequate to prove her attorney was reasonably diligent in the critical time period.

While it is not necessary for an attorney to drop all other work and focus exclusively on the invention in question to establish reasonable attorney diligence, it is necessary to show that "the attorney worked reasonably hard on

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the particular application in question during the continuous critical period." Bey v. Kollonitsch, 806 F.2d 1024, 1027, 231 USPQ 967, 969 (Fed. Cir. 1986) (footnote [7] omitted). The evidence presented by Oates simply does not enable us to ascertain what activity, if any, Mr. Morris was engaged in with respect to Oates' application on any particular date. Thus, for example, from the date of receiving additional information from Oates (OX-5), March 10, 1988, until the day of Mr. Morris' letter (OX-6) transmitting the first draft of Oates' application to Ms. Oates on April 28, 1988, some 49 (forty-nine) days, there is no evidence establishing what Mr. Morris was doing with respect to preparing the Oates' application for filing. Indeed, the record shows no other activity. Reasonable diligence must be directed towards reducing to practice the subject matter of the count.

Additionally, unlike the facts in Bey, Oates has not shown that Mr. Morris' records establish that he took up the five other applications he testified he worked on in the critical period in chronological order. As the court noted in Bey, 806 F.2d at 1028, 231 USPQ at 970, "the attorney has the burden of keeping good records of the dates when cases are docketed as well as the dates when specific work is done on

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the applications." (footnote omitted). There is simply no evidence in this record which establishes what work Mr. Morris performed with respect to any particular application on any particular date in question. As the party with the burden of persuasion, that was Oates' burden.

Nonetheless, Oates urges that we should conclude from the evidence of the above-noted sporadic activity by Oates or her agents during the critical time period that the time intervals which intervene between the evidence of actual activity should be presumed to have been spent by Morris or others actively acting on filing her application. However, contrary to Oates' argument, it does not necessarily follow from the evidence before us that Mr. Morris was actively engaged in working on the Oates' application during every time period for which there is no evidence of activity. The simple fact is we do not know from the record before us what work Mr. Morris performed on what dates or on what application. Indeed, Mr. Morris' testimony on this matter is revealing.

On cross examination, Mr. Morris conceded that he did not keep any records of how he spent his time on a daily basis (OR p.228, lines 9 through 23) and that he had no written records indicating how much time he spent on any



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particular aspect of Oates' case (OR p.238, lines 6 through 23). Moreover, Mr. Morris could not identify any of the five additional applications he testified he filed between December 15, 1987, and May 12, 1988 (OR p. 239-40). Nor could he recall what ratings the applications were assigned (OR p. 241). Mr. Morris could not remember what action he took between March 10, 1988, and April 28, 1988, with respect to the Oates' application (OR p. 244, line 23) and Mr. Morris admitted that nothing in the exhibits on which Oates relies describes any specific activity (OR p. 246, lines 13 through 24).

Oates has simply failed to present adequate evidence on this record on which we could find the exercise of reasonable diligence by Mr. Morris, her attorney, during the critical time period. While it is certainly possible that Mr. Morris and Oates' agents were actively engaged on every day during the critical period in working towards filing the Oates' application or working on other cases in his docket, we simply have not been presented with any evidence establishing exactly what work was performed by Mr. Morris or when any specific work was performed by Mr. Morris. Oates has simply failed to satisfy her burden of persuasion on this issue.

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**ABANDONMENT, SUPPRESSION AND CONCEALMENT**

On June 5, 1992, Rivetti et al. filed notice that they intended to argue that Oates abandoned, suppressed or concealed an actual reduction to practice as required by 37 C.F.R. § 1.632. See Paper Number 41.

Nevertheless, "without an actual reduction to practice there is no invention in existence which can be abandoned, suppressed, or concealed." Peeler v. Miller, 535 F.2d at 651, 190 USPQ at 120. Because Oates has not presented any evidence of priority based on an actual reduction to practice, it is Rivetti et al.'s burden to establish by a preponderance of the evidence that Oates abandoned, suppressed or concealed her invention within the meaning of 35 U.S.C. § 102(g). Gallagher v. Smith, 206 F.2d 939, 99 USPQ 132 (CCPA 1953).

We agree with Oates for reasons expressed in her reply brief at page 4 thereof that Rivetti et al. have failed to prove that Oates actually reduced to practice an embodiment within the Count at a time prior to Rivetti et al.'s Italian application benefit date of March 4, 1988.

**JUDGMENT**

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Having decided all the issues properly raised by the parties in their briefs, it is now appropriate for us to enter judgment in this interference pursuant to our authority under 37 C.F.R. § 1.658(a). Accordingly:

Judgment as to the subject matter of Count 1 in this interference is awarded to Franco Rivetti, Fiorenzo Renzi and Ugo Romano, the senior party. Franco Rivetti, Fiorenzo Renzi and Ugo Romano, the senior party, are entitled to a patent containing claims 10 through 29 of their involved application corresponding to Count 1.

Judgment as to the subject matter of Count 1 in this interference is awarded against Stephanie J. Oates, the junior party. Stephanie J. Oates, the junior party, is not entitled to

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her involved patent containing claims 1 through 29  
corresponding to Count 1.

IAN A. CALVERT	)	
Administrative Patent Judge	)	
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MARC L. CAROFF	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
ANDREW H. METZ	)	
Administrative Patent Judge	)	

AHM/gjh

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Attorney(s) for Oates:

Patent Department  
PPG Industries, Inc.  
One PPG Place  
Pittsburgh, PA 15272

Attorney(s) for Rivetti et al.

George P. Hoare, Jr. et al.  
Roger & Wells  
200 Park Avenue  
New York, NY 10166-0153

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